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09/535,790

03/29/2000

Deirdre O'Shea

99-032

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08/27/2004

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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/535,790

Applicant(s)

O'SHEA ET AL

Examiner

John L Young

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WJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-167 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-74, 87, 94, 95, 144-153 and 162-167 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 75-86, 88-93, 96-143 and 154-161 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.

PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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REOPENING OF PROSECUTION /WITHDRAWAL FROM APPEAL

NON-FINAL OFFICE ACTION REJECTION (PAPER # 14)

1. Withdrawal from appeal is deemed necessary because of new grounds of argument herein presented.

ELECTION ACKNOWLEDGED

2. Applicant's election without traverse of Group I (claims 1-47, 48-57, 58-74, 87, 94-95, 144-153 & 162-167) in Paper No. 8 is acknowledged. (NOTE: Claim 1 is considered generic).

DRAWINGS

3. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

4. Claims 1-74, 87, & 162-167 are rejected under 35 U.S.C. 101, because the claims are directed to non-statutory subject matter.

As per independent claims 1-74, 87 & 162-167, as drafted, said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972), *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature Financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed. Cir. 1998); *At & T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999). Note: It is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that

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~~are not recited in the claims." (See MPEP 2173.05 (q)) said claims are not limited by language in the claims to a practical application within the technological arts associated with activity within a computer. "A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness." See Alappat, 33, F.3d at 1543, 31 USPQ2d at 1556-57 (quoting Diamond v. Diehr, 450 U.S. at 192, 209 USPQ at 10).~~

CLAIM REJECTIONS — 35 U.S.C. §103(a)

5. Rejections maintained for claims 1-74, 87, 94-95, 144-153 & 162-167.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-74, 87, 94-95, 144-153 & 162-167 are rejected under 35 U.S.C. §103(a) as being obvious over Christensen US 5,710,886 (Jan. 20, 1998) (herein referred to as "Christensen") in view of Kanter US 5,537,314 (Jul. 16, 1996) (herein referred to as ("Kanter").

As per independent claim 1, Christensen (the ABSTRACT; FIG. 1 through FIG. 14; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6,

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ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; and col. 17, ll. 1-44) shows the establishing an initial benefit for a coupon . . . notice and updating elements that suggest the elements and limitations of claim 1.

Christensen lacks an explicit recitation of the "variation condition" elements and limitations of claim 1, even though Christensen ~~suggests implicitly shows~~ same.

Kanter (the ABSTRACT; FIG. 1; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6, ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; col. 17, ll. 1-44; col. 18, ll. 7-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; col. 22, ll. 1-67; col. 23, ll. 2-67; col. 24, ll. 1-67; col. 25, ll. 1-67; col. 26, ll. 1-67; col. 27, ll. 1-67; and col. 28, ll. 1-67) shows ~~elements that suggest~~ the "variation condition" elements and limitations of claim 1.

Kanter proposes "variation condition" modifications that would have applied to the system of Christensen. It would have been obvious to a person of ordinary skill in the art the time of the invention that the teaching of Kanter would have been combined with the system of Christensen because such combination would have provided means for *"a participant can join in a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings. . . . wherein discounts apply on calls placed to certain individuals by those that recruited the individuals. . . . To provide an incentive*

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award program which can motivate participants to make referrals on behalf of the program. . . ." (see Kanter (col. 13, ll. 13-20; col. 14, ll. 20-25; and col. 15, ll. 3-5)); and because such combination would have provided means *"to improve consumer response to coupon distribution campaigns. . . . It is a further object of the present invention to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign."* (see Christensen (col. 4, ll. 40-60)).

As per claims 2-47, Christensen in view of Kanter shows the method of claim 1 and the methods of subsequent claims depending from claim 1. (See the rejection of claim 1 supra).

Christensen (the ABSTRACT; FIG. 1 through FIG. 14; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6, ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; and col. 17, ll. 1-44) implicitly shows ~~the elements that suggest the elements and limitations of claims 2-47.~~

Christensen lacks explicit recitation of some of the elements and limitations of claims 2-47, even though Christensen suggests same.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 2-47 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would

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have provided means for *"a participant can join in a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings. . . . wherein discounts apply on calls placed to certain individuals by those that recruited the individuals. . . . To provide an incentive award program which can motivate participants to make referrals on behalf of the program. . . ."* (see Kanter (col. 13, ll. 13-20; col. 14, ll. 20-25; and col. 15, ll. 3-5)); and because such combination would have provided means *"to improve consumer response to coupon distribution campaigns. . . . It is a further object of the present invention to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign."* (see Christensen (col. 4, ll. 40-60)).

Independent claim 48 is rejected for substantially the same reasons as independent claim 1.

As per claims 49-57, Christensen in view of Kanter shows the method of claim 48 and the methods of subsequent claims depending from claim 48. (See the rejection of claim 48 supra).

Christensen (the ABSTRACT; FIG. 1 through FIG. 14; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6, ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-

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67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; and col. 17, ll. 1-44) implicitly shows elements that suggest the elements and limitations of claims 49-57.

Christensen lacks explicit recitation of some of the elements and limitations of claims 49-57, even though Christensen ~~suggests-implicitly shows same~~.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 49-57 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means for *"a participant can join in a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings. . . . wherein discounts apply on calls placed to certain individuals by those that recruited the individuals. . . . To provide an incentive award program which can motivate participants to make referrals on behalf of the program. . . ."* (see Kanter (col. 13, ll. 13-20; col. 14, ll. 20-25; and col. 15, ll. 3-5)); and because such combination would have provided means *"to improve consumer response to coupon distribution campaigns. . . . It is a further object of the present invention to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign."* (see Christensen (col. 4, ll. 40-60)).

Independent claim 58 is rejected for substantially the same reasons as independent claim 48.

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As per claims 59-74, Christensen in view of Kanter shows the method of claim 58 and the methods of subsequent claims depending from claim 58. (See the rejection of claim 58 supra).

Christensen (the ABSTRACT; FIG. 1 through FIG. 14; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6, ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; and col. 17, ll. 1-44) implicitly shows all of the elements that suggest the elements and limitations of claims 59-74.

Christensen lacks explicit recitation of some of the elements and limitations of claims 59-74, even though Christensen suggests-implicitly shows same.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 59-74 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and the advantages would have provided means for *"a participant can join in a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings. . . . wherein discounts apply on calls placed to certain individuals by those that recruited the individuals. . . . To provide an incentive award program which can motivate participants to make referrals on behalf of the program. . . ."* (see Kanter (col. 13, ll. 13-20; col. 14, ll. 20-25; and col. 15, ll. 3-5)); and because such combination would have provided means

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"to improve consumer response to coupon distribution campaigns. . . . It is a further object of the present invention to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign." (see Christensen (col. 4, ll. 40-60)).

Independent claim 87 is rejected for substantially the same reasons as independent claim 1.

Independent claims 94-95 are rejected for substantially the same reasons as independent claim 1.

Independent claim 144 is rejected for substantially the same reasons as independent claim 48.

Independent claims 145-148 are rejected for substantially the same reasons as independent claim 1.

Independent claims 149-153 are rejected for substantially the same reasons as independent claim 48.

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Independent claims 162-167 are rejected for substantially the same reasons as independent claim 58.

RESPONSE TO ARGUMENTS

7. Applicant's election without traverse of Group I (claims 1-47, 48-57, 58-74, 87, 94-95, 144-153 & 162-167) in Paper No. 8 is acknowledged. (NOTE: Claim 1 is considered generic).

Applicant's response fails to seasonably challenge Official Notice evidence presented in the Prior Office Action.

It is well settled that "Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. . . . A challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice. . . . If [A]pplicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, [A]pplicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made " (See MPEP 2144.03 Reliance on Common Knowledge in the Art or 'Well Known' Prior Art 8 ed., August 2001, pp. 2100-129 and 2100-130).

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In this instance, Applicant's Response fails to demand a reference in support of the Official Notice evidence cited by the Examiner in the prior Office action concerning the obviousness rejections of the claims which were rejected based on Official Notice.

And, Applicant's response lacks adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice and thereby fails to seasonably challenge the Official Notice rejections of the instant invention; therefore, said Official Notice evidence is deemed admitted.

CONCLUSION

8. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive

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Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-

3900

John L. Young


JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

August 23, 2004